

## **REMARKS**

### **I. Status and Disposition of the Claims**

In the instant application, claims 1-3, 5-19, 21-35 and 37-60, of which claims 1, 17 and 33 are independent, are pending and under consideration on the merits.

In the Office Action<sup>1</sup> mailed September 29, 2008, the following actions were taken:

1) claims 1, 17, 33 and 46-60 were rejected under 35 U.S.C. §103(a) as being unpatentable over US Pub. No. 2003/0046281, by Son (hereinafter "*Son*") in view of US Pub. No. 2002/0194195, by Fenton et al. (hereinafter "*Fenton*");

2) claims 2-16, 18-32, 34, 35 and 37-45 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of *Son* and *Fenton* and further in view of US Pat. No 5,222,234, by Wang (hereinafter "*Wang*").

### **II. Amendments to the Claims**

In this Amendment and Response to the Office Action, Applicant amends claims 1, 17 and 33 to incorporate the elements of now-cancelled claims 2, 18 and 34 respectively and to correct a grammatical error. In addition, Applicant updates the dependency of claims 3, 19 and 35. Moreover, Applicant amends claim 44 to correct a misspelling.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

### III. Response to Rejections

In this Response to the Office Action, Applicant respectfully traverses the rejections listed above.

#### **A. The Rejection of the Claims under 35 U.S.C. §103(a) for *Son* in view of *Fenton* is Improper.**

Applicant respectfully traverses the above identified rejection of claims because a *prima facie* case of obviousness has not been established. "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007) held that "[t]here is no necessary inconsistency between the idea underlying the TSM [teaching, suggestion, motivation] test and the *Graham* analysis." M.P.E.P. §2141 (rev. 6, Sept. 2007), citing *KSR* at 82 U.S.P.Q. 2d at 1396. Applicant understands this to mean that when applicable, as here, TSM reasoning may still be applied not only by an examiner but also by Applicant to refute a §103 rejection.

Here, a *prima facie* case of obviousness has not been established because the scope and content of the prior art has not been properly determined, nor have the differences between the claimed invention and the prior art been properly ascertained. Accordingly, a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art has not been clearly articulated.

Claims 1, 17, 33 and 46-60 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Son* in view of *Fenton*. See Office Action at page 2. Regarding claim 1, in particular, the Office Action contains the assertion, "It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Son* to include... limitation as taught by *Fenton* ." See Office Action at 3. Applicant respectfully disagrees with the assertion and traverses the rejection for at least the reasons stated below.

A fair reading of *Son* and *Fenton* reveals that the references fail to teach or suggest each and every element of amended claim 1. As noted above, amended claim 1 includes the elements of cancelled claim 2, namely the recitation "the system location compris[es] a folder" (See claim 1). The Office Action has already asserted that, "[T]he combination of *Son* and *Fenton*... does not disclose wherein the system location

comprises a folder.” See Office Action at 4. Therefore, the cited references fail to teach or suggest each and every element of claim 1.

The § 103(a) rejection of claim 1 as being unpatentable over *Son* in view of *Fenton* is improper, and should be withdrawn.

For at least the reasons noted above, the 103(a) rejection of claims 17 and 33, which recite similar elements and were rejected under the same rationale, and claims 46-60, which depend directly or indirectly from claims 1, 17 and 33, is improper and should be withdrawn.

**B. The Rejection of the Claims under 35 U.S.C. §103(a) for *Son* and *Fenton* in view of *Wang* is Improper.**

Claims 3, 5-16, 19, 21-32, 35 and 37-45 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of *Son* and *Fenton* in view of *Wang*. In addition, cancelled claims 2, 18 and 34, the elements of which have now been incorporated into amended claims 1, 17 and 33 were rejected for the same reason. In connection with its rejection of claims 2, 18 and 34, the Office Action contained the assertion, “It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify [*Son* and *Fenton*] to include wherein the system location comprises a folder as taught by *Wang*.” In addition, the Office Action cited *Wang*, in combination or alone with *Son* and *Fenton*, as teaching features recited in claims 3 and 5-16, but not recited in claim 1. See Office Action at page 4-7. Applicant respectfully disagrees with the assertions and traverses the rejection for at least the reasons stated below.

As set forth above with respect to amended claim 1, the combination of *Son* and *Fenton* fails to teach, disclose or suggest the features now recited in amended claim 1, and required by claims 3 and 5-16, namely, that “a system location compris[es] a folder”. Even assuming the Office Action’s assertions concerning a hypothetical combination of *Son*, *Fenton* and *Wang* are correct, *Wang* fails to cure the deficiencies of *Son* and *Fenton* discussed above. That is, *Wang* also fails to teach, disclose or suggest, “after executing the search query, providing an input mechanism by means of which a user may select at least one resource from the at least one search result, for preserving the selected at least one resource in a system location comprising a folder, wherein preserving the selected at least one resource comprises maintaining content of the selected at least one resource in the state at which the content existed at the time of preservation,” as recited in amended claim 1 and required in claims 3 and 5-16.

The Office Action cites *Wang*’s col. 3, line 64 through col. 4, line 5 as teaching, “the system location comprises a folder,” as recited in amended claim 1. See Office Action at 4. Applicant disagrees with this assertion. *Wang*’s col. 3, line 64 through col. 4, line 5 refers to a document interchange architecture in a library wherein folder documents are created that contain other documents. Therefore, the Office Action appears to be asserting that *Wang*’s library is somehow analogous to Applicant’s system location. This is not correct. In *Wang*, a user executes a search command to locate documents in *Wang*’s library. “Documents that satisfy a specified search criteria are returned to one of the users 10 making the search request.” See *Wang* at col. 4, lines 45-49. However, Applicant’s recited system location is **not** recited to be the location where a user executes a search command to locate documents. Applicant’s

recited system location is for “**preserving** the selected at least one resource” “**after** executing the search query.” See claim 1. (Emphasis added). Therefore, if assuming *arguendo* that *Wang*’s library can somehow be analogized to an element recited in claim 1, *Wang*’s library would not be analogous to Applicant’s system location. Therefore, *Wang*’s col. 3, line 64 through col. 4, line 5 cannot suggest that “the system location” as recited in amended claim 1, comprises a folder. Further, nowhere else in *Wang* is there a suggestion of “preserving the selected at least one resource in a system location comprising a folder.”

Because neither *Son* nor *Fenton* nor *Wang* disclose “after executing the search query, providing an input mechanism by means of which a user may select at least one resource from the at least one search result, for preserving the selected at least one resource in a **system location comprising a folder**, wherein preserving the selected at least one resource comprises maintaining content of the selected at least one resource in the state at which the content existed at the time of preservation,” as recited in amended claim 1, the cited references fail to teach or suggest each and every element of claim 1.

Moreover, one of ordinary skill in the art would not find it obvious to modify the apparatus of the combination of *Son* and *Fenton*, using the teachings of *Wang*, to achieve the required combination recited by amended claim 1. Applicant submits that while examiners may rely upon what is generally known in the art, they **must provide evidentiary proof** of that knowledge. See *In re Zurko*, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001) (“With respect to core factual findings in a determination of patentability . . . the Board cannot simply reach conclusions based on its own understanding or expertise

... Rather, the Board **must point to some concrete evidence** in the record in support of these findings.”) (emphasis is added).

Here, Applicant respectfully submits that the Office Action has not explained *why* or *how* one of ordinary skill would modify a hypothetical combination system of *Son* and *Fenton*, using the teachings of *Wang*, so as to arrive at the claimed invention. In particular, the Office Action has not explained at least: (a) *why* one of ordinary skill would modify steps of *Son* and/or *Fenton* so as to designate a system location and preserve the “selected at least one resource” in the system location; and, especially, (b) *how* one of ordinary skill would know to select and arrange steps of *Son*, *Fenton* and *Wang* so as to arrive at a system with the claimed features of “after executing the search query, providing an input mechanism by means of which a user may select at least one resource from the at least one search result, for preserving the selected at least one resource in a system location comprising a folder, wherein preserving the selected at least one resource comprises maintaining content of the selected at least one resource in the state at which the content existed at the time of preservation,” as recited in amended claim 1.

The burden is on the Patent Office to provide some tenable rationale as to *why* one of ordinary skill in the art would combine *Son*, *Fenton* and *Wang* so as to arrive at the presently claimed methods recited in the claims. In the present case, however, no such rationale has been provided.

For all of the §103 rejections except for that of claim 2, the Office Action merely asserts, “The combination of *Son*, *Fenton* and *Wang* discloses the elements of the claimed invention as noted above and, furthermore, discloses [the feature recited in the

claim].” None of these assertions demonstrate *why* or *how* one would modify a hypothetical *Son/Fenton* combination with *Wang*’s features so as to arrive at the claimed invention.

The only statement in the Office Action about why one would combine *Son*, *Fenton* and *Wang* appears on page 4 of the Office Action in connection with the rejection of claim 2. The Office Action contains the assertion, “It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include wherein the system location comprises a folder as taught by *Wang* **for the purpose of saving similar content in an easily accessible memory location.**” See Office Action at 4. (Emphasis added)

At best, the Office Action’s assertion could be considered an assertion that the proposed modifications could be performed. However, “[t]he mere fact that a reference can be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01 (emphasis in original). Combining *Son*, *Fenton* and *Wang* would not result in a predictable variation of Applicant’s invention because a hypothetical *Son/Fenton/Wang* combination, which would lack a recited element, would not be a variation of Applicant’s invention at all. *Son*, *Fenton* and *Wang* lack the elements recited in amended claim 1, namely “preserving the selected at least one resource in a system location comprising a folder.”

Further, even assuming *arguendo* that the Office Action’s assertion is correct, “saving similar content in an easily accessible memory location” is not sufficient motivation for including a folder as a system location in *Son* and *Fenton*, since nowhere



in *Son* and *Fenton* is there a suggestion of saving similar content together in a system location. There would be no point to *Son* and *Fenton* including a folder as a system location to save similar content together if *Son* or *Fenton* does not store similar content in designated system locations. Therefore, combining *Wang* with *Son* and *Fenton* misses the objective of the Applicant's system as recited in amended claim 1.

For at least these reasons, Applicant submits that the Office has not met the burdens necessary to establish that present claims 1, 3, 5-16 are obvious under §103(a). Therefore the §103(a) rejection of claims 1, 3, 5-16 is improper, and should be withdrawn.

For at least the reasons noted above, claims 17, 19, 21-33, 35 and 37-45 which recite similar elements and were rejected under the same rationale, are allowable under 35 U.S.C. 103(a). See Office Action at pages 3-7.

#### **IV. Conclusion**

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the reconsideration of its "Final" status and the reexamination of the application, and the timely allowance of the pending claims.

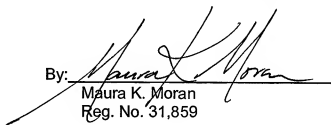
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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